

**REMARKS**

Reconsideration and allowance of the above-referenced application are respectfully requested in light of the above-marked amendments and the foregoing remarks. The Examiner is encouraged to contact the undersigned at +1.858.314.1535 to discuss this Response.

**Rejection under 35 U.S.C. § 112, second paragraph**

The Office has rejected claim 132-142 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Office asserts on page 2 of the Office Action that usage of the term “computing means for” is incorrect as the features that include this term are modified by some structure, material, or acts in the claim.

In response, claims 132-142 have been amended to replace the term “computing means” by the term “module,” as recited at least in independent claims 78 and 105. This amendment is completely supported by the original specification, at least at FIG. 3, which is shown below along with the arguments in response to the rejections under 35 U.S.C. §103(a). It is respectfully submitted that the amendments to claims 132-142 obviate the basis of the rejection under 35 U.S.C. § 112, second paragraph. Therefore, the rejection under 35 U.S.C. § 112, second paragraph should be withdrawn.

**Rejections under 35 U.S.C. §103(a)**

Claims 78-80, 84, 85, 87-97, 99-107, 111, 112, 114-124 and 126-142 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2003/0069869 to Gronau et al. (hereinafter “Gronau”) in view of U.S. Patent No. 6,411,936 to Sanders (hereinafter “Sanders”) and U.S. Patent Application Publication No. 2004/0039619 to

Zarb (hereinafter "Zarb"). Claims 98 and 125 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gronau in view of Sanders, Zarb, and U.S. Patent Application Publication No. 2002/0147626 to Zagotta et al. (hereinafter "Zagotta"). These rejections are respectfully traversed.

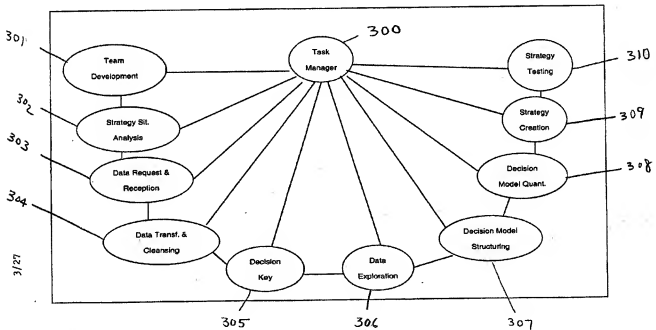
For a proper rejection under 35 U.S.C. §103(a), the Office "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness" and must therefore present "a clear articulation of the reason(s) why the claimed invention would have been obvious." MPEP §2142. An obviousness rejection "cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." MPEP §2141 quoting *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1386, 1385 (2007). This rationale must include a showing that all of the claimed elements were known in the prior art and that one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, to produce a combination yielding nothing more than predictable results to one of ordinary skill in the art. *KSR*, 82 USPQ2d at 1395. MPEP §2141.02 further notes that "a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The rejection fails to satisfy this burden with regards to the currently pending claims.

Claim 78 recites, inter alia, the following feature: "each module of the plurality of modules occurring in a predetermined sequence of the plurality of modules such that each module occurs once in the predetermined sequence, wherein output of each module of the predetermined sequence is an input of a next module in the predetermined sequence until control

is passed to a last sequential module in the predetermined sequence, wherein each module of the predetermined sequence interacts with an expert task manager, wherein said expert task manager provides expert knowledge about strategy modeling processes to the modules.”

Amended claim 78 is directed to a plurality of modules including a team development module, strategy situation module, data request and reception module, data transformation and cleansing module, decision key and intermediate variable module, data exploration module, decision model structuring module, decision model quantification module, strategy creation module, and strategy testing module. The above-mentioned feature is supported by the original specification, at least at Fig. 3 (shown below), TABLE C, and associated text.

Fig. 3

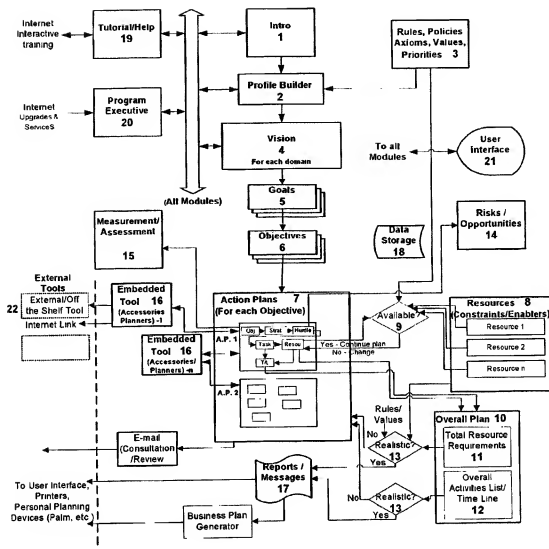


Original specification at Fig. 3

As noted in the original specification at Fig. 3, the plurality of modules occur in a sequence such that each module occurs once and that output of each module is an input of the next module until control is passed to the last module (e.g. strategy testing module 310). Although of different

scope, dependent claims 133-142 more clearly specify passing of control from one module to another module in a sequence. Each module (i.e., each of 301, 302, 303, 304, 305, 306, 307, 308, 309, and 310) can be accessed using a task manager 300.

In contrast to claim 78, Gronau describes an enterprise performing a series of steps 1-22 on an application to perform strategic planning by using a strategy plan. For example, see Gronau at FIG. 1, which has been reproduced below for convenience. The strategy plan constitutes optimum allocation of resources available in a resource database. To perform the strategic planning, the enterprise uses a profile builder to create a profile of the enterprise on the application. The profile consists of current financial information of the enterprise. Then, the enterprise defines rules (including policies, axioms, values and priorities) that need to be used to achieve the objectives. The defining of the rules includes either (a) selecting the rules out of a predefined rules database, or (b) creating the rules, adding the created rules to the rules database, and selecting the added rules out of rules stored in the rules database. Subsequent to the above-mentioned defining of the rules, the enterprise defines, using the defined rules, objectives that need to be achieved. Based on the objectives, the available resources are assessed and allocated according to each corresponding objective. A measurement and assessment function keeps a track of status of activities and achievement of the objectives in the strategy planning process.



Gronau at FIG. 1

Throughout the Office Action, the Office asserts that Gronau's steps 1-22 (as noted above with respect to Gronau at FIG. 1) constitute the modules recited in claim 78. However, it is submitted that the amendment to claim 78 obviates the basis of this assertion, at least in view of the reasons that follow.

To begin with, the Office relies on Gronau's assessment of available resources (steps 3 and 8) for the claimed team development module, relies on Gronau's development of vision and goals (steps 4 and 5) for the claimed strategy situation analysis module, relies on Gronau's

defining and assessment of rules (steps 3 and 8) for the claimed data request and reception module, relies on Gronau's defining of rules (step 3) for the claimed data transformation and cleansing module, relies on Gronau's defining of rules (steps 3) for the claimed decision model quantification module, relies on Gronau's development of vision and goals (steps 4 and 5) for the claimed strategy creation module, and relies on Gronau's tracking status of activities by measurement/assessment function (step 15) for the claimed strategy testing module. Thus, the Office relies on the steps of Gronau at FIG. 1 in a random order rather than in the order of steps from step 1 to step 22, as shown by Gronau at FIG. 1. On the contrary, amended claim 78 requires that all modules occur in a predetermined sequence (e.g. sequence shown by original specification at Fig. 3 shown above) such that until a last module of the sequence is reached, output of each module is an input to the next module. However, the Office relies on Gronau's modules in a random order, which obviates the possibility of an output of each module to be an input to the next module in a predetermined sequence, as necessitated by claim 78. Therefore, Gronau cannot possibly be relied upon for the following limitation of claim 78: "wherein output of each module of the predetermined sequence is an input of a next module in the predetermined sequence until control is passed to a last sequential module in the predetermined sequence."

Further, the Office relies on same steps of Gronau for multiple modules claimed separately. As one example, the Office relies on Gronau's step 3 for at least the claimed team development module, the claimed request and reception module, and the claimed decision model quantification module. However, claim 78 has been amended to recite that each module in the sequence occurs once (e.g. see original specification at Fig. 3 shown above), rather than a particular step (which has been relied upon for a module) being repeated multiple times, as taught by Gronau. For at least this reason, Gronau fails to cure the following limitation of claim

78: "each module of the plurality of modules occurring in a predetermined sequence of the plurality of modules such that each module occurs *once* in the predetermined sequence." Emphasis added.

As per the reasons noted above, it is completely incorrect to rely on Gronau's steps for the modules required by claims 78. In view of the foregoing, Gronau fails to disclose or suggest the following feature of claim 78: "each module of the plurality of modules occurring in a predetermined sequence of the plurality of modules such that each module occurs once in the predetermined sequence, wherein output of each module of the predetermined sequence is an input of a next module in the predetermined sequence until control is passed to a last sequential module in the predetermined sequence, wherein each module of the predetermined sequence interacts with an expert task manager, wherein said expert task manager provides expert knowledge about strategy modeling processes to the modules."

Further, the Office acknowledges on pages 6 and 7 of the Office Action that Gronau fails to disclose or suggest the claimed decision key and intermediate variable creation module 305 (see original specification at Fig. 3 shown above), and the claimed data exploration module 306. To cure these deficiencies of Gronau, the Office relies on Sanders and Zarb. However, this reliance is respectfully disagreed-upon as follows.

To begin with, Sanders and Zarb, whether taken individually or in combination, fail to cure the above-noted deficiencies of Gronau.

Further, claim 78 has been amended to require that that all modules occur in a predetermined sequence (e.g. sequence shown by original specification at Fig. 3 shown above) such that until a last module of the sequence is reached, output of one module is an input to the next module. Accordingly, for an appropriate combination of Gronau with Sanders, the Office

needs to show that the output of a module (e.g. data transfer and cleansing module 304) prior to the decision key and intermediate variable creation module 305 should be similar to input to the relied-upon alleged module in Sanders. Furthermore, for an appropriate combination of Gronau, Sanders and Zarb, the Office needs to show that the output of a module (e.g. decision key module 305) prior to the data exploration module 306 should be similar to input to the relied-upon alleged module in Zarb. However, it is believed that the Office has failed to provide the above-noted showings for an appropriate combination of Gronau, Sanders, and Zarb. Therefore, it is incorrect to combine Gronau, Sanders, and Zarb for rejecting the features of claim 78.

In view of at least the reasons noted above, it is respectfully submitted that that a *prima facie* case for obviousness has not been established and claim 78 should be in condition for allowance. Therefore, claim 78 is allowable over Gronau, Sanders, and Zarb, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of claim 78, as well as claims 79, 80, 84, 85, 87-97, and 99-104, at least by reason of their dependency, should be withdrawn.

Independent claims 105 and 132 have been amended to recite features similar to those noted above with respect to claim 78. Therefore, claims 105 and 132, as well as claims 106, 107, 111-112, 114-124, 126-131, and 133-142, at least by reason of their dependency, are allowable over Gronau, Sanders, and Zarb, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of those claims should be withdrawn.

Moreover, it is submitted that claims 133-142 have been amended to clarify features of those claims. These amendments to claims 133-142 are completely supported by the original specification, at least at TABLE C, Fig. 3, and associated text. It is respectfully submitted that these amendments further differentiate the claims from the cited references. For this additional



reason, claims 133-142 are allowable over Gronau, Sanders, and Zarb, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of those claims should be withdrawn.

Claim 98 depends from claim 78 and includes all the features recited therein. Further, it is submitted that Zagotta fails to cure the above-noted deficiencies of Gronau, Sanders, and Zarb. Accordingly, claim 98 is allowable over Gronau, Sanders, Zarb, and Zagotta, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of claim 98 should be withdrawn for at least this reason.

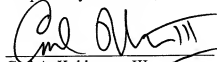
Claim 125, although of different scope, includes features similar to those noted above with respect to claim 98. Therefore, claim 125 is allowable over Gronau, Sanders, Zarb, and Zagotta, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of claim 125 should be withdrawn for at least this reason.

### **Conclusion Comments**

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Applicant asks that all claims be allowed.

If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below. The Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 35006-556F01US.

Respectfully submitted,



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